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DAVID ROTH

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02/03/2005

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EXAMINER

ABRAMS, NEIL

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GROUP 2800

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/024,885
Filing Date: February 17, 1998
Appellant(s): ROTH ET AL.

Stuart A Whittington
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 12, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 80-85, 94, 117-126, 133-140 and 150-156.

Claims 144-149, upon review of arguments in Brief are allowed.

Claims 128, 141-149 are allowed.

Claims 1-79, 86-93, 95-116, 127, 129-132 and 157-163 are been canceled.

As to the Brief , page 2, footnote 1, the reasons for allowance for claim 80 was intended only to apply to Aldous, fig 10 disclosure applied without a secondary reference.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on May 6, 2004 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The rejections of claims 144-149 is withdrawn.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,241,974	Hardesty	12-1980
5,183,404	Aldous et al.	2-1993
5,395,268	Okada	3-1995

Research Disclosure (RD), No. 31788 Kenneth Mason Publications, Ltd. England
09-1990.

Other references applied in the final rejection are withdrawn as cumulative.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 80-85, 94, 117-123 and 133-140 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldous in view of Hardesty and Research Disclosure document (RD)).

Note initially that the appellants arguments are directed only to a combination that would be fully covered by claim 80 limitations. Therefor all claims included in this rejection should stand or fall with the decision on patentability of claim 80.

For claim 80, Aldous, fig. 8, 9 discloses a system with a card body 40 having a connector 56 with an RJ receptacle 36.

Aldous does not disclose (1) use of a "receptacle module to interface with a communications line, the receptacle module having a portion for removable insertion into the card body to form a unitary module" or (2) "an overall length of the unitary module in a configuration that is within the PCMCIA type III standard".

Hardesty discloses a receptacle module (adapter) for use with an RJ socket and enabling use with a pair rather than a single RJ plug and also to provide an upwardly facing socket at 54'.

RD discloses a receptacle adapter which may be used to add components for lowering electrical noise and/or provide a change in shape to enable a right angle plug in direction.

It would have been obvious to one skilled in the art to use any such type removable module (adapter) with the Aldous card 40 to enable use with a pair rather than only one input/output plug, to enable use of a component to lower electrical noise or to change plug-in direction to one that is more convenient. Any of these changes would be advantages that would provide motivation for use of the Hardesty/RD teachings.

As to the type III length limitation, it has been held that a change in size is generally recognized as being within the level of ordinary skill in the art". In re Rose, 105 USPQ 237 (CCPA 1955).

In this case, it would have been obvious to form the card body/module overall length to be of such dimension as not to extend unduely outward of a computer with which it is to be use or of such length as to enable it to be easily carried for use in different locations.

In this regard, note claim 80 only refers to the length limitation but provides no tie in with features that enable such length limitation to be achieved.

Even in specification and arguments this length limitation is set forth as "preferable" page 61, lines 11, 12, but no structural change is specifically referred to as enabling the device to be provided at such length. Applicant has not shown how this length aspect is to be achieved and in the absence of such disclosure, the mere recitation that the unitary module is within a certain standard should not overcome the references as applied above.

Claims 124-126 and 150-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldous in view of Okada.

Applicant's arguments with regard to thee claims are directed only to the combination as set forth in claim 124, therefor the claims included in this rejection should stand or fall with the decision on the patentability of claim 124.

Aldous, figs. 10, 11,15, 20,21, discloses a card body 74 with a sliding drawer 72 having a recess 130 to receive a RJ plug 38 when the drawer is open and with contacts 114 in the recess. The device does not include a "movable bottom" that provides shielding of electrical conductors of the plug as recited in claim 124.

Okada, figs. 3-5 show a card having a recess 38 with a movable bottom (stop) 40 with a floor 18 that would provide bottom covering or shielding of the electrical conductors 24 of the plug 14.

It would have been obvious to use such a movable box in the Aldous (figs 20,21) card sliding drawer 72. This would enable use of a jack which is thinner and flatter than that previously used and that would provide some shielding or covering for the plug conductors 114 of the plug 38 when received in the recess 130. It would also enable the plug to fit more deeply into the receptacle hence provide a lower profile. See Okada, col 2, lines 60-65.

(11) Response to Argument

For claim 80, appellant argues that motivation for the combination of references is lacking. The examiner urges that Hardesty and RD teach use of adapters for change in plug-in direction for user convenience, RD teaches adapter use for noise reduction and Hardesty also suggests adapter use to enable multiple rather than a single connection means, such as enabling signal input from two telephone lines. Anyone of these would provide motivation for using such type adapters with the Aldous, figs. 8, 9, card.

Appellant on page 8, lines 19-23, asserts that Aldous is specifically designed for use without any intermediate adapter. The examiner urges that the Aldous comments are readable as meaning that no adapter is required. The comments do not mean that it would be unobvious to use an adapter providing motivation for such use be present.

Appellant also argues that the combination does not teach use of a length within the PCMCIA type III standard. The Examiner urges that it would have been obvious to form the combined device to be of appropriate length for the intended use. Appellant in spec and arguments does not point out any specific detail of the card and module that enable it to be formed of the recited length. Such use of terms with no tie in to enabling structure should not provide basis for finding the terms to define an unobvious limitation in this case. In addition, nowhere in appellants specification is any advantage or purpose for use of the type III length discussed. Appellant basically only states that the overall length is "preferably and substantially within the PCMCIA Type III standard". See page 61, lines 8-12. Therefor this feature, with no stated tie in to a specific purpose, is considered a matter of obvious design, as discussed above.

Appellant on page 9, lines 19-23 uses a "may not extend beyond the host devicecompliant" argument. Exactly what feature this refers to is unclear since not related to any material clearly set forth in the disclosure. Elected figs 22-25 do not include any depiction of a host device. Only fig. 1 is seen to include a host device together with card and module, however this figure does not seem to bear any relationship to the "overall length/PCMCIA Type III" limitation at issue. Therefor these arguments provide no clear basis for avoidance of the rejection.

For claim 124, appellant, on page 10, argues that since Aldous already has a stop, the skilled artisan would not look to Okada for teachings of use of a stop.

The examiner urges that it would have been obvious to use a different type of stop, one that permits the card to be made thinner that would allow deeper insertion of

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the plug into the socket and that would provide a degree of protection or closure not present in the current Aldous structure.

Appellant also argues that Okada is "silent that movable bottom 18 may serve to seal pug contacts".

Claim 124 calls for the bottom to "shield" electrical conductors of the plug. It seems clear from the bottom 18 would provide shielding for the contacts of plug 14. Note that the claims do not require shielding on specific sides of the plug therefor do not define over Okada type shielding by box 40 even if only provided on the lower face of the plug 14, see fig. 5.


For the above reasons, it is believed that the rejections should be sustained.

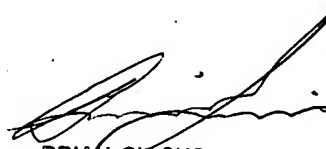
Respectfully submitted,

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